REMARKS

In the above-noted Office Action, the drawings were objected to on the grounds that a marked-up copy of the replacement sheets was not provided. The only changes to the drawings were changes in the numerical identifiers, with such changes being unambiguously described in the Response to Office Action Mailed on February 21, 2006. In any event, Applicants have filed herewith an annotated copy of each of the seven replacement sheets, showing the changes as requested in the Office Action.

As indicated in the subject Office Action, Claims 4 – 11, 13, 14, 19 – 21 and 23 have been allowed. Dependent Claim 3 was said to be directed to allowable subject matter. In addition, Claims 1 – 2 and 15 – 17 were rejected in view of the various cited prior art. Claims 1, 15 and 17 have been amended by way of the present Response.

Claim 1 was rejected for being anticipated by USPNo. 6,010,157 to Pierson (hereinafter Pierson). Claim 1 has been further amended and is believed to be patentable over the cited prior art.

Claim 1 is directed to a book binding apparatus for binding a stack of sheets, an exemplary embodiment of which is shown in Figs. 1 – 3 of the subject application. Among other things, the Claim 1 apparatus includes a "first cover section having dimensions that generally correspond to dimensions of the sheets" of the stack to be bound. A "flap member" is provided which "is attached to the first cover section and [is] pivotable at a first location along the first cover section". Also included are a "first section of pressure sensitive adhesive" on the "first cover section" and a "second section of pressure sensitive adhesive" on the "flap member". A "first release liner [is] disposed over the first section of pressure sensitive adhesive" and a "second release liner [is] disposed over said second section of pressure sensitive adhesive". Claim 1 further recites that "said flap member is movable between a closed position where the first release liner can contact said second release liner and an open position where the flap member is positioned away from said first release liner".

In rejecting Claim 1 in view of Pierson, element 18 is said to be the claimed "first cover section" and adhesive 48a is said to be the claimed "first section of pressure sensitive adhesive" which is said to be "along a first edge" 28 of the "first cover section". Element 44 is said to be the claimed "flap member", with 48b being

the "second section of pressure sensitive adhesive". The "flap member 44 is said to be "attached to the first cover section 18 (through intermediate sections 38, 22 and 42) and pivotable at a first location 32 along the first cover section ...".

Applicants are not able to follow the various configurations of the Pierson apparatus which the Examiner relies upon in rejecting Claim 1. In one configuration, it is stated that the claimed pivot location of the "flap member" is met when "sections 38 and 22 are put into contact with one another". Then it is stated that when the flap member 44 is moved to the closed position, the release liners for adhesive sections 48a and 48b "will touch". Although it is not clear, it appears that the Examiner is of the view that it is proper to arrange the Pierson elements in one configuration to meet one set of claim limitations and to then rearrange the elements to meet another claim limitation. The only manipulations recited in Claim 1 relates to movement of the "flap member" between "an open position where the first release liner can contact said second release liner and an open position where the flap member is positioned away from said first release liner." It is not known, for example, how the release liners for adhesives 48a and 48b can "touch" while at the same time "sections 38 and 22 are put in contact with each other". In fact, it is not know how the two release liners can ever touch without doing violence to the Pierson structure by, for example, folding elements backwards. Of course, whatever arrangement of the Pierson structure is proposed, there must be some suggestion or teaching in the prior art for such arrangement.

Notwithstanding the appropriateness of the various proposed Pierson configurations, Applicants have amended Claim 1 to recite that the "first section of pressure sensitive adhesive [is] disposed on the first cover section along a first edge of the first cover section". Adhesive 48a of Pierson is not disposed on section 18 and would serve no purpose if it were. Further, Claim 1 has been amended to recite that "flap member" is "directly attached to the first cover section" as opposed to Pierson where these two elements are said to be attached "through intermediate sections 38, 22, and 42". Directly attaching member 44 to member 20 of Pierson is nowhere suggested in the art since such an arrangement would clearly render the apparatus useless for its intended purpose or for any purpose.

Thus, amended Claim 1 is believed to be patentable as are Claims 2 and 3 which depend from Claim 1 and add patentably significant limitations to the claim.

Rejected Claim 15 is directed to a book binding apparatus, with one exemplary embodiment being depicted in Fig. 10 of the subject application. Among other things, the apparatus includes a "folded sheet having a fold" and "an elongated spine element" which includes "adhesive matrix of heat activated adhesive disposed on the substrate". Claim 15 has been amended to recite that the "spine element and folded sheet [are] attached together exclusively by way of a connection between regions immediately adjacent the longitudinal first edge of the spine element and immediately adjacent the fold in the folded sheet". Claim 15 has been further amended to recite that the "spine element [has] a length that generally corresponds to a length of the fold" and to recite that the "the matrix of heat activated adhesive [extends] substantially a full length of the spine element".

Claim 15 was rejected for being anticipated by USPNo. 4,511,289 to Jones (hereinafter "Jones"). Sheet 12 is said to be the "folded sheet" and 14 is said to be "elongated spine element". A section of Jones (Col. 3, line 31 – 36) is cited for the proposition that Jones uses a heat activated adhesive. "Elongated spine element" 14 is, in fact, a length of transparent tape member 14 (Col. 3, line 61 et seq), having a pressure sensitive adhesive covered by a pair of "release papers 30" which are removed during the assembly process. A narrow underlying central portion of tape 14 is secured to the spine 20 ("rear edge 20") by way of a heat activated adhesive as explained in that portion of the text cited in the Office Action. Thus, Jones uses a pressure sensitive for binding rather than a heat activated adhesive. Since only the central portion of transparent tape is connected to anything, both outer edges of the "elongated spine element" 14 are free. Thus, tape 14 and cover sheet 12 are not "attached together" in the manner recited in Claim 15. It is important that the most of transparent tape 14 of Jones remain free and not attached to the cover sheet 12 so that the free ends can be applied to the respective front and rear pages of the items being bound, such as magazines. This permits a user to fully view the front and rear pages through the transparent tape as explained at Col. 3, line 61 et seq. after binding.

Claim 15 was also rejected for being anticipated by USPNo. 4,385,225 to Giulie (hereinafter "Giulie"). Further details of the binding structure disclosed in Giulie and disclosed in USPNo. 4,471,976, the application for which is referenced at Col. 1, line 6 et seq. of Giulie. Giulie is said to disclose a "folded sheet" 21 and an

"elongated spine element" 12. As noted above, Claim 15 has been amended in several respects. The "longitudinal first edge" of the elongated binding strip 19 of Giulie is normal to the fold in file folder 21. It can be seen that adhesive 14 does not extend "substantially a full length of the elongated spine element" as recited in amended Claim 15. It can also be seen from Fig. 3 of Giulie that end portion 19 of the binder strip 12 is attached to folder 21 over a wide area extending from the fold in the folder 21 all the way to the outer edge binding strip 12, with that outer edge being parallel to, but displaced from, the fold line. Thus, even if the outer edge of elongated binder strip 12 were a "longitudinal edge" (which it is not), the claimed structure for exclusively attaching two elements together as recited above is not present.

It should also noted that the structure recited in Claim 15 is ideal for the method shown in Figs 12A – 12H of the present application where the folded sheets are both disposed on a common side of the stack being bound. The structure of Giulie, on the other hand, it optimized for the arrangement shown in Figs 2 and 3 of Giulie where the stack being bound is disposed between the folded sheets. Thus, given the objective of the Giulie structure, there would no motivation for one skilled in the art to somehow modify the structure to arrive at the invention of Claim 15 which is adapted for meeting a distinctly different objective.

For the above reasons, it is submitted that amended Claim 15 is patentable over both Jones and Giulie, as are Claims 16 and 17 which depend, either directly or indirectly, from Claim 15 and add patentably significant limitations to the claim.

In conclusion, all pending claims are in condition for allowance and an early allowance is respectfully requested.

Respectfully submitted,

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